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Attorney for Applicant

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PATENTDocket No. 2779.2.2

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	David R. Montague	)
		)
Serial No.:	09/488,079	)
		) Art Unit:
Filed:	January 20, 2000	) 3622
		)
For:	COMPUTER-READABLE MEDIUM PRODUCT	)
	LABEL APPARATUS AND METHOD	)
		)
Examiner:	James W. Myhre	)

TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA, 22313-1450

Dear Sir:

Please find enclosed herewith an Request for Reinstatement of Appeal and Supplemental Appeal Brief and credit card payment (Form PTO-2038) in the amount of Two Hundred Fifty Dollars (\$250.00) to cover the fees prescribed by 37 C.F.R. 1.17(c) for filing an Appeal Brief.

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**PATENT****Docket No. 2779.2.2****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**REQUEST FOR REINSTATEMENT OF APPEAL AND**  
**SUPPLEMENTAL APPEAL BRIEF**

Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA, 22313

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Sir:

This paper is filed in response to the Office Action mailed February 7, 2005. That Office Action reopened prosecution after the Board of Patent Appeals and Interferences (Decision of September 9, 2004) reversed all of the examiner's previous rejections. Accordingly, Appellant requests reinstatement of the appeal, and submits herewith the following Supplemental Appeal Brief.

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**I. REAL PARTY IN INTEREST**

E-TAGZ, L.L.C. (hereinafter "Appellant") is the Real Party in Interest as the sole owner of the new technology embodied in the above-identified patent application. Inventor David R. Montague assigned all rights, title, and interest to the above-identified patent application to E-TAGZ, L.L.C.

**II. RELATED APPEALS AND INTERFERENCES**

To the knowledge of Appellant and his legal counsel, there are no pending appeals or interferences that will directly effect or will be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

Claims 1-28 are currently in the case.

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,153,842 issued to Dlugos Sr. et al. (hereinafter "Dlugos") in view of U.S. Application Publication No. 2001/0003041 A1 published for Redford et al. (hereinafter "Redford").

**IV. STATUS OF AMENDMENTS**

Appellant filed an amendment to the claims of the above-identified patent application on June 3, 2003. The amendment was entered and there have been no subsequent amendments to the claims.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

In certain embodiments, the present invention may provide a product label or tag 60, 410 coupled to a computer-readable medium. (See Figure 5 and page 35, lines 7-15.) The label 60, 410 may be formed to display information 484. The information 484 may include facts about the product or the product's source. Information 484 may be conveyed directly through the use of printed words, symbols, trademarks, service marks, pictures, and the like. The information 484 may also be conveyed through the selection of the color or shape of the label 60, 410. (See Figures 3,4, & 10 and page 34, lines 2-14.)

In one embodiment, the computer-readable medium may include an optical medium such as a CD-ROM 460 or DVD 468. In other embodiments, the computer-readable medium may include a magnetic medium such as a magnetic strip 464 or floppy disk 470. (See Figure 10 and page 35, lines 1-3.) Software available on the computer-readable medium product label 60, 410 may include a launcher, browser, viewer, e-mail, facsimile sender, player, or other executables as well as vendor data. (See page 3, line 21 through page 4, line 1.)

The computer-readable medium product label 60, 410 may be configured to be attached to a variety of products 412 including clothing, toys, footgear, machinery, headgear, foodstuffs, furniture, appliances, sporting goods, dry goods, tools, and plants. The label 60, 410 may be configured to be attached to the product 412 or the product packaging 492. The label 60, 410 may be attached to the product 412 in a manner to protect the label 60, 410 from damage during shipping. (See Figures 11-17 and page 4, lines 6-10.)

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The rejection of claims 1-28, as being unpatentable under 35 U.S.C. § 103(a) over Dlugos in view of Redford, is presented for review.

**VII. ARGUMENT****Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dlugos in view of Redford.

The Manual of Patent Examining Procedure § 2143.01 recites the well established doctrine that a proposed modification cannot change the principle of operation of a reference. When a proposed modification or combination of the prior art does change the principle of operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In Re Rattim*, 270 F.2d 810 (CCPA 1959).

In the present case, modifying the automatic, wireless interaction of Dlugos to incorporate the manual disk-insertion of Redford would change the principle of operation of Dlugos. Accordingly, the combination of Dlugos and Redford is not sufficient to render claims 1-28 *prima facie* obvious.

As stated in Dlugos, the problem with the prior art is that it requires “a great deal” of manual effort. (Dlugos column 2, line 20.) Accordingly, the objectives of Dlugos are to provide “a more convenient and efficient form in which to transport information” and “a more convenient form in which to store information.” (Dlugos column 2, lines 22-26.) These objectives “are achieved” by an integrated circuit card that is attached to a parcel. (Dlugos column 2, lines 30-33.) Information “may be stored on the card by an automatic

terminal” and the information stored on the card “may be read by an automatic terminal.”  
(Dlugos column 2, lines 35-39.)

This “automatic” reading and writing is accomplished through the use of communications in the form of “infrared, visible light, or other radiation, radio frequency transmissions, or variations in a magnetic field” as well as “acoustical or ultrasonic communication.” (Dlugos column 4, lines 23-32.) That is, Dlugos’ invention operates on the principle of wireless interaction. Wireless interaction permits Dlugos to achieve the stated objectives of improved convenience and reduced manual effort.

In direct contrast, Redford operates on the principle of manual disk-insertion. In the very paragraph upon which the examiner bases his rejections, Redford states that a “user removes the optical disk from the holder and inserts the optical disk into a storage media drive 124 in host device 120.” (Redford page 7, paragraph 0105, emphasis added.) Based on this language, the examiner asserts that “[o]ne would have been motivated to include software on the disk” of Redford with the “item in Dlugos.” (Office Action mailed February 2, 2005 page 3, lines 15-21.) However, this would require Dlugos to abandon the principle of wireless interaction, with its advantages of speed and convenience, for one of manually removing and inserting a disk. Because this proposed modification or combination of Dlugos and Redford would change the principle of operation of Dlugos, Dlugos and Redford are incompatible references. Accordingly, the teachings of Dlugos and Redford are not sufficient to render Appellant’s claims 1-28 obvious.

In view of the foregoing, Appellant asserts that the combination of Dlugos and Redford cannot render obvious Appellant’s claimed invention. Appellant respectfully requests that the rejections of claims 1-28 be withdrawn and that claims 1-28 be allowed.

Additionally, Appellant desires to maintain the dignity and decorum requisite to patent prosecution. This matter seems to demand that Appellant bring certain facts to the attention of the Board of Patent Appeals and Interferences. On multiple occasions, Examiner Myhre boasted to Appellant's counsel regarding the low number of patent applications he, Examiner Myhre, allows. See *Statement of the Substance of the Interview Summary* filed November 18, 2003. It was apparent to Appellant's counsel that Examiner Myhre believed that the fewer the allowed cases, the better the examiner.

Moreover, in a personal interview conducted on October 30, 2003, Examiner Myhre stated that if he were overturned on appeal he would simply find new art and maintain the rejection of the claims of the above-identified patent application based on the new art. See *Statement of the Substance of the Interview Summary* filed November 18, 2003. This approach to patent examination is improper. See MPEP §1214.05. However, regardless of this impropriety, Examiner Myhre has now made good on his promise. On September 9, 2004, the Board of Patent Appeals and Interferences reversed all of Examiner Myhre's previous rejections and on February 7, 2005, Examiner Myhre mailed a new rejection of all claims based on new art.

In view of Examiner Myhre's stated intention to deny patentability regardless of the opinions of this Board and proper PTO procedure, Appellant respectfully requests that the above-identified patent application be assigned to a new examiner.

DATED this 12<sup>th</sup> day of April, 2005.

Respectfully submitted,



A. John Pater  
Registration No. 36,234  
Attorney for Applicant

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Date: April 12, 2005

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**IX. APPENDIX****Claims as They Currently Stand**

1. (previously amended) An apparatus comprising:  
a label configured to be affixed to a product at a source thereof;  
the product having a surface associated therewith;  
the label configured to directly communicate first information corresponding to at least one of the product and a source of the product; and  
a computer readable medium, storing instructions executable by a computer of a purchaser of the product, coupled to the product by the label.
2. (original) The apparatus of claim 1, wherein the first information is printed on the label.
3. (original) The apparatus of claim 2, wherein the first information is contained in a selection of color on the label.
4. (previously amended) The apparatus of claim 1, wherein the label is shaped to provide the first information through a trademark symbol corresponding to at least one of the product and the source of the product.
5. (original) The apparatus of claim 1, wherein the computer-readable medium contains second information comprising at least one of product facts, source facts, new product facts, service facts, a game, a data gathering interface, a test, a browser, a launcher, and a network identifier corresponding to a location of additional information.

6. (original) The apparatus of claim 1, wherein the product includes at least one of a garment, footwear, headgear, a toy, a foodstuff, furniture, an appliance, sporting goods, dry goods, a tool and a plant.

7. (original) The apparatus of claim 6, wherein the product is placed with respect to the label to protect the label prior to purchase.

8. (original) The apparatus of claim 1, wherein the label includes at least one of a hang tag and a hanging tag, substantially enclosing a computer-readable medium.

9. (original) The apparatus of claim 1, wherein the computer-readable medium includes at least one of a printed medium, an electromagnetic medium, an optical medium, and a firmware medium.

10. (original) The apparatus of claim 9, wherein the computer-readable medium is formatted in at least one of the formats including compact disk, floppy disk, digital video disk, magnetic strip, bar code, symbolic code, and an embedded chip.

11. (previously amended) An apparatus comprising:  
a label configured to be affixed to packaging substantially enclosing a product at a source thereof, and the packaging having an exterior;  
the label configured to directly communicate first information corresponding to at least one of the product and a source of the product;  
the packaging substantially enclosing the product; and  
a computer-readable medium coupled to the packaging by the label and containing instructions executable on a computer of a user.
12. (original) The apparatus of claim 11, wherein the first information is printed on the label.
13. (original) The apparatus of claim 12, wherein the first information is contained in a selection of color on the label.
14. (previously amended) The apparatus of claim 11, wherein the label is shaped to provide the first information through a trademark symbol corresponding to at least one of the product and the source of the product.
15. (original) The apparatus of claim 11, wherein the computer-readable medium contains second information comprising at least one of product facts, source facts, new product facts, service facts, a game, a data gathering interface, a test, a browser, a launcher, and a network identifier corresponding to a location of additional information.

16. (original) The apparatus of claim 11, wherein the label includes at least one of a hang tag and a hanging tag, substantially enclosing the computer-readable medium.

17. (original) The apparatus of claim 11, wherein the computer-readable medium includes at least one of a printed medium, an electromagnetic medium, an optical medium, and a firmware medium.

18. (previously amended) An apparatus comprising:  
a label configured to be affixed to a product at a source thereof, the product having an exterior;  
the label configured to be attached to a tether having a first end and a second end;  
the first end configured to be coupled to the label;  
the second end configured to be coupled to the exterior of the product, such that the tether couples the label to the exterior of the product;  
the label configured to directly communicate first information corresponding to at least one of the product and a source of the product; and  
a computer-readable medium coupled to the label and containing instructions executable on a computer of a user.

19. (original) The apparatus of claim 18, wherein the first information is printed on the label.

20. (original) The apparatus of claim 19, wherein the first information is contained in a selection of color on the label.

21. (previously amended) The apparatus of claim 18, wherein the label is shaped to provide the first information through a shape trademark symbol corresponding to at least one of the product and the source of the product.

22. (original) The apparatus of claim 18, wherein the computer-readable medium contains second information comprising at least one of product facts, source facts, new product facts, service facts, a game, data gathering interface, a test, a browser, a launcher, and a network identifier corresponding to a location of additional information.

23. (original) The apparatus of claim 18, wherein the product defines an opening to an interior of the product and at least part of the label is positioned in the interior of the product.

24. (previously amended) A method comprising:  
configuring a label to directly communicate first information corresponding to at least one of a product and a source of the product;  
coupling a computer-readable medium to the label, the computer readable medium containing instructions executable of a computer of a user of the product; and  
coupling the label to an exterior of the product.

25. (original) The method of claim 24, wherein the product is packaged.

26. (original) The method of claim 24, wherein the label is coupled to the exterior of the product by a flexible member.

27. (previously presented) An apparatus comprising:

a label affixed to a product at a source thereof to be viewable by a prospective purchaser and located proximate an outer surface of at least one of the product and the product packaging at a point of sale;

the product having a surface associated therewith;

the label configured to directly communicate advertising information to a purchaser thereof, the advertising information corresponding to at least one of the product and a source of the product; and

a computer readable medium, storing at least one executable computer program independent from the product, and loadable and executable by a computer of a purchaser of the product, the medium being physically coupled to the product by a substrate of the label.

28. (previously presented) An apparatus comprising:

a label configured to be affixed to a product at a source thereof to display at a point of sale;

the product having a surface associated therewith;

the label configured to directly communicate advertising information to a purchaser thereof, the advertising information corresponding to at least one of the product and a source of the product; and

a computer readable medium, storing instructions, independent from the product, executable by a computer of a purchaser of the product, physically coupled to the product by the label.